

U.S. Patent Appln. Serial No. 09/800,997
Amendment After Final Rejection dated June 13, 2005
August 18, 2005

REMARKS

Claims 1-28, 66 and 69-72 are pending in this application. Claims 29-65 and 67-68 are canceled. Claims 69-72 have been added. The Specification has been amended to correct a typographical error. Claims 1-5, 7, 8, 16-24, 28 and 66 have been amended. No new matter has been added by way of amendment. Support for the amendments and new claims can be found at least in the Specification as originally filed at p. 5, line 21 to p. 6, line 4; p. 7, lines 11-19; p. 9, lines 12-22; Fig. 3; claims 1-68.

Claims 1-3, 10-11, 15-16, 18-20, 25, 27 and 66 are rejected under 35 U.S.C. § 102(a) as allegedly anticipated by European Patent Application No EP 1-014-318 A2 to Yamaguchi ("Yamaguchi"). Claims 4-9, 12-13, 17, 21-24, 26 and 28 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Yamaguchi in view of U.S. Patent No. 6,390,362 to Martin ("Martin"). Claim 14 is rejected under 35 U.S.C. § 103(a) as allegedly obvious over Yamaguchi in view of U.S. Patent No. 5,432,506 to Chapman ("Chapman").

L. Claim Rejections Under 35 U.S.C. § 102(a).

Claims 1-3, 10-11, 15-16, 18-20, 25, 27 and 66 are rejected under 35 U.S.C. § 102(a) as allegedly anticipated by Yamaguchi. *See* Final Rejection at ¶ 7. Applicants respectfully submit that Yamaguchi does not disclose each and every element of claims 1, 18 and 66, as amended, and therefore does not anticipate claims 1, 18 and 66, or any claims dependent from claims 1, 18 and 66, and that this rejection should be withdrawn.

A. Claims 1, 18 and 66.

The Examiner states that Yamaguchi discloses a "system, its method and electronically readable medium for remotely generating an instrument comprising: a) a processor that receives from a customer a request for the instrument (See Yamaguchi abstract, figures 2 step S8 and paragraph [0010] and [0023]); b) generates the instrument in electronic form (See Yamaguchi abstract, figures 2 step S11, and paragraph [0010]-[0013] and [0025]); c) adds a first security image in electronic form to the electronic form of the instrument to create a composite image (See Yamaguchi abstract, figures 2 step S12, and paragraph [0010]-[0013] and [0025]); and d) a communications module that transmits the composite image in electronic form to the customer for printing by the customer (See Yamaguchi abstract, figures 2 step S12, and paragraph [0010]-[0013] and [0025]-[0026], where transmits corresponds to sent)." *See* Final Rejection at ¶ 8.

U.S. Patent Appln. Serial No. 09/800,997
Amendment After Final Rejection dated June 13, 2005
August 18, 2005

Applicants respectfully submit that Yamaguchi does not disclose at least the limitation of claims 1, 18 and 66 of transmitting to a customer a composite image comprising a first security image in electronic form added to the electronic form of an instrument that has been requested by the customer for printing by the customer on a medium, wherein the first security image is visible on the instrument printed on the medium. Rather, Yamaguchi discloses making security data from ticket issue request data and user identification data sent from a user via a communications means, making ticket image data from the ticket issue request data and transmitting to the user ticket printing data made by embedding the security data in the ticket image data, where the security data is *invisible* against the ticket image data when the ticket printing data including the ticket image data and the security data is printed on ticket paper by the user. *See* Yamaguchi, [0010], line 44-45; [0012], lines 57-58; [0013], lines 6-7; [0034], lines 7-8; [0050], lines 57-58; [0062], lines 48-49; [0088], lines 31-32; [0091], lines 41-42; [0092], lines 44-45; claims 1, 15, 16; Figs. 5, 22, 23.

Since Yamaguchi does not disclose each and every limitation of claims 1, 18 and 66, and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer, Applicants respectfully request that this rejection be withdrawn against claims 1, 18 and 66.

B. Claims 2 and 19.

The Examiner states that as per claims 2 and 19, Yamaguchi discloses "all the limitations of claims 1 and 18, wherein the first security image comprises a watermark that appears as a part of the composite image when printed (See Yamaguchi figures 3-8, paragraphs [0034], [0044], [0049]-[0050] and [0062], where watermark corresponds to data to be embedded in the image data in the invisible state)." *See* Final Rejection at ¶ 9.

Applicants respectfully submit that at least for the reasons stated in Sec. I(A) *supra* that Yamaguchi does not disclose each and every limitation of claims 2 and 19, which depend from claims 1 and 18, and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer. Therefore, Applicants respectfully request that this rejection be withdrawn against claims 2 and 19.

C. Claims 3 and 20.

The Examiner states that as per claims 3 and 20, Yamaguchi discloses "all the limitations of claims 2 and 19, wherein the first security image is invisible on a photocopy of the instrument

U.S. Patent Appln. Serial No. 09/800,997
Amendment After Final Rejection dated June 13, 2005
August 18, 2005

(See Yamaguchi abstract, figures 2 step S12, and paragraph [0010]-[0013], [0034]-[0035], and [0084]-[0084])." *See* Final Rejection at ¶ 10.

Applicants respectfully submit that at least for the reasons stated in Secs. I(A) and I(B) *supra* that Yamaguchi does not disclose each and every limitation of claims 3 and 20, which depend from claims 2 and 19, and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer. Therefore, Applicants respectfully request that this rejection be withdrawn against claims 3 and 20.

D. Claim 10.

The Examiner states that as per claim 10, Yamaguchi discloses "all the limitations of claim 1, wherein the instrument comprises a monetary instrument (See Yamaguchi figure 23, paragraph [0092], where monetary instrument corresponds to enable a user issue what has a value equal to money)." *See* Final Rejection at ¶ 11.

Applicants respectfully submit that at least for the reasons stated in Sec. I(A) *supra* that Yamaguchi does not disclose each and every limitation of claim 10, which depends from claim 1, and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer. Therefore, Applicants respectfully request that this rejection be withdrawn against claim 10.

E. Claim 11.

The Examiner states that as per claim 11, Yamaguchi discloses "all the limitations of claim 10, wherein the instrument represents certified funds (See Yamaguchi figure 23, paragraph [0092], where monetary instrument corresponds to enable a user issue what has a value equal to money like postage stamps. Stamps are certified funds used for variety of transactions and fee payments especially in official correspondence)." *See* Final Rejection at ¶ 12.

Applicants respectfully submit that at least for the reasons stated in Sec. I(D) *supra* that Yamaguchi does not disclose each and every limitation of claim 11, which depends from claim 10, and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer. Therefore, Applicants respectfully request that this rejection be withdrawn against claim 11.

F. Claim 15.

The Examiner states that as per claim 15, Yamaguchi discloses "all the limitations of claim 10, wherein the request comprises at least one of an amount, a denomination and a

U.S. Patent Appln. Serial No. 09/800,997
Amendment After Final Rejection dated June 13, 2005
August 18, 2005

currency of the monetary instrument (See Yamaguchi figure 3, and paragraphs [0010]-[0013] [0023] and [0031])." See Final Rejection at ¶ 13.

Applicants respectfully submit that at least for the reasons stated in Sec. I(D) *supra* that Yamaguchi does not disclose each and every limitation of claim 15, which depends from claim 10, and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer. Therefore, Applicants respectfully request that this rejection be withdrawn against claim 15.

G. Claims 16 and 27.

The Examiner states that as per claims 16 and 27, Yamaguchi discloses "all the limitations of claims 1 and 18, further comprising a step of e) associating a unique identifier number with the instrument (See Yamaguchi figure 3, and paragraphs [0010]-[0013] [0023], [0031] and [0035])." See Final Rejection at ¶ 14.

Applicants respectfully submit that at least for the reasons stated in Sec. I(A) *supra* that Yamaguchi does not disclose each and every limitation of claims 16 and 27, which depend from claims 1 and 18 respectively, and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer. Therefore, Applicants respectfully request that this rejection be withdrawn against claims 16 and 27.

H. Claim 25.

The Examiner states that as per claim 25, Yamaguchi discloses "all the limitations of claim 18, wherein the instrument comprises a monetary instrument that represents certified funds (See Yamaguchi figure 23, paragraph [0092], where monetary instrument corresponds to enable a user issue what has a value equal to money) and the instrument represents certified funds (See Yamaguchi figure 23, paragraph [0092], where monetary instrument corresponds to enable a user issue what has a value equal to money like postage stamps. Stamps are certified funds used for variety of transactions and fee payments especially in official correspondence)." See Final Rejection at ¶ 15.

Applicants respectfully submit that at least for the reasons stated in Sec. I(A) *supra* that Yamaguchi does not disclose each and every limitation of claim 25, which depends from claims 18 and 23, and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer. Therefore, Applicants respectfully request that this rejection be withdrawn against claim 25.

U.S. Patent Appln. Serial No. 09/800,997
Amendment After Final Rejection dated June 13, 2005
August 18, 2005

I. Claims 69, 71 and 72.

Applicants respectfully submit that for at least for the reasons stated in Sec. I(A) *supra* that Yamaguchi does not disclose each and every limitation of new claims 69, 71 and 72, which depend from claims 1, 18 and 66, respectively, and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer. Therefore, Applicants respectfully request that Yamaguchi similarly does not anticipate new claims 69, 71 and 72.

II. Claim Rejections Under 35 U.S.C. § 103(a).

Claims 4-9, 12-13, 17, 21-24, 26 and 28 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Yamaguchi in view of Martin. *See* Final Rejection at ¶ 18. Claim 14 has been rejected under 35 U.S.C. § 103(a) as allegedly obvious over Yamaguchi in view of Chapman. *See* Final Rejection at ¶ 25. Applicants respectfully submit that neither Yamaguchi in combination with Martin nor Yamaguchi in combination with Chapman disclose each and every limitation of claims 4-9, 12-14, 17, 21-24, 26 and 28, and that this rejection be withdrawn for failing to form a *prima facie* case of obviousness.

A. Claims 4-6 and 21-22.

The Examiner states that Yamaguchi discloses all the limitations of claims 3 and 20, and that Martin “clearly discloses the presence of secondary security image on the instrument visible only when the instrument has been copied and displaying the word ‘Void’ (See Martin, column 2, lines 11-15 and 21-24 and column 4, lines 21-39).” *See* Final Rejection at ¶ 19. According to the Examiner, “it would have been obvious to one having ordinary skill in the art at the time the current invention was made to further include additional security images such as pantographs spelling out certain words or images (Void or Copy, etc.) for the motivation of better security and fraud prevention.” *Id.*

Applicants respectfully submit that, as discussed in Sec. I(A) *supra*, Yamaguchi does not disclose at least the limitation of claims 1 and 18 of transmitting to a customer a composite image comprising a first security image in electronic form added to the electronic form of an instrument that has been requested by the customer for printing by the customer on a medium, wherein the first security image is visible on the instrument printed on the medium. Rather, Yamaguchi discloses making security data from ticket issue request data and user identification data sent from a user via a communications means, making ticket image data from the ticket

U.S. Patent Appln. Serial No. 09/800,997
Amendment After Final Rejection dated June 13, 2005
August 18, 2005

issue request data and transmitting to the user ticket printing data made by embedding the security data in the ticket image data, where the security data is *invisible* against the ticket image data when the ticket printing data including the ticket image data and the security data is printed on ticket paper by the user. *See* Yamaguchi, [0010], line 44-45; [0012], lines 57-58; [0013], lines 6-7; [0034], lines 7-8; [0050], lines 57-58; [0062], lines 48-49; [0088], lines 31-32; [0091], lines 41-42; [0092], lines 44-45; claims 1, 15, 16; Figs. 5, 22, 23.

Martin discloses an inventive check that includes a barcode, which includes at least one of the following pieces of information: the date the check was paid, the amount of the check, the payee, the drawers account number, the bank's routing number, and the identifier number of the check. *See* Martin, Abstract; col. 4, lines 5-19; col. 5, lines 7-14; col. 7, lines 38-42. Martin also provides for a method for preventing check fraud which includes attaching a machine readable code on a negotiable instrument and creating a negotiable instrument, where the drawee receives the negotiable instrument and scans the machine readable bar code. *See* Martin, Abstract. However, Martin does not disclose at least the limitation of claims 1 and 18 of transmitting to a customer a composite image comprising a first security image in electronic form added to the electronic form of an instrument that has been requested by the customer for printing by the customer on a medium, wherein the first security image is visible on the instrument printed on the medium.

Since claims 4-6 depend from claim 1 and claims 21-22 depend from claim 18, Yamaguchi in combination with Martin does not disclose each and every limitation of claims 4-6 and 21-22, and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer. Therefore, Applicants respectfully request that this rejection be withdrawn against claims 4-6 and 21-22 for failure to form a *prima facie* case of obviousness.

B. Claims 7-9 and 23-24.

The Examiner states that Yamaguchi discloses all the limitations of claims 1 and 18, and that Martin "clearly discloses the presence of secondary security image on the instrument visible only when the instrument has been copied and displaying the word "Void" (See Martin, column 2, lines 11-15 and 21-24 and column 4, lines 21-39). *See* Final Rejection at ¶ 20. According to the Examiner, "it would have been obvious to one having ordinary skill in the art at the time the current invention was made to further include additional security images such as pantographs

U.S. Patent Appln. Serial No. 09/800,997
Amendment After Final Rejection dated June 13, 2005
August 18, 2005

spelling out certain words or images (Void or Copy, etc.) for the motivation of better security and fraud prevention.” *Id.*

As discussed *supra* in Sec. II(A), Yamaguchi in combination with Martin does not disclose each and every limitation of claims 1 and 18, and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer. Therefore, Applicants respectfully request that this rejection be withdrawn against claims 7-9 and 23-24, which depend from claims 1 and 18, for failure to form a *prima facie* case of obviousness.

C. Claim 12.

The Examiner states that Yamaguchi discloses all the limitations of claim 11, and that Martin “clearly discloses that a financial entity such as a bank is the generator of the instrument and the bank is grantor of the payment of the face amount to the payee from the payor’s account held at the bank (See Martin abstract, column 3, line 55-column 4, line 2 and column 8, lines 10-19).” See Final Rejection at ¶ 21. According to the Examiner, “it would have been obvious to one having ordinary skill in the art at the time the current invention was made to have the financial institution certify the financial instrument created and drawn on an account of an account holder and printed for the motivation of further security of the financial or negotiable instrument and presence of the funds to cover such instrument.” *Id.*

As discussed *supra* in Sec. II(A), Yamaguchi in combination with Martin does not disclose each and every limitation of claim 1 (from which claim 12 depends), and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer. Therefore, Applicants respectfully request that this rejection be withdrawn against claim 12, which depends from claims 1 and 11, for failure to form a *prima facie* case of obviousness.

D. Claim 13.

The Examiner states that Yamaguchi discloses all the limitations of claim 12, and that Martin “clearly discloses that the funds are withdrawn from the customer’s deposit account (See Martin abstract, column 3, line 55-column 4, line 2 and column 8, lines 10-19).” See Final Rejection at ¶ 22. According to the Examiner, “it would have been obvious to one having ordinary skill in the art at the time the current invention was made to have the financial institution withdraw the funds from the account of the account holder for the motivation of

U.S. Patent Appln. Serial No. 09/800,997
Amendment After Final Rejection dated June 13, 2005
August 18, 2005

further security of the financial or negotiable instrument and presence of the funds to cover such instrument." *Id.*

As discussed *supra* in Sec. II(C), Yamaguchi in combination with Martin does not disclose each and every limitation of claim 12 (from which claim 13 depends), and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer. Therefore, Applicants respectfully request that this rejection be withdrawn against claim 13 for failure to form a *prima facie* case of obviousness.

E. Claim 26.

The Examiner states that Yamaguchi discloses all the limitations of claim 25, and that Martin "clearly discloses that a financial entity such as a bank is the generator of the instrument and the bank is grantor of the payment of the face amount to the payee from the payor's account held at the bank (See Martin abstract, column 3, line 55-column 4, line 2 and column 8, lines 10-19)." See Final Rejection at ¶ 23. According to the Examiner, "it would have been obvious to one having ordinary skill in the art at the time the current invention was made to have the financial institution certify the financial instrument created and drawn on an account of an account holder and printed for the motivation of further security of the financial or negotiable instrument and presence of the funds to cover such instrument." *Id.*

As discussed *supra* in Sec. II(A), Yamaguchi in combination with Martin does not disclose each and every limitation of claim 18, and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer. Therefore, Applicants respectfully request that this rejection be withdrawn against claim 26, which depends from claim 18, for failure to form a *prima facie* case of obviousness.

E. Claims 17 and 28.

The Examiner states that as per claims 17 and 28, Yamaguchi "is not explicit [that] the composite image is for printing on a medium having a second security image the second security image is invisible on the instrument and is visible on a photocopy of the instrument." See Final Rejection at ¶ 24. According to the Examiner, "Martin clearly discloses the presence of secondary security image on the instrument visible only when the instrument has been copied (See Martin, column 2, lines 11-15 and 21-24 and column 4, lines 21-39). *Id.* According to the Examiner, "it would have been obvious to one having ordinary skill in the art at the time the current invention was made to further include additional security images such as pantographs

U.S. Patent Appln. Serial No. 09/800,997
Amendment After Final Rejection dated June 13, 2005
August 18, 2005

spelling out certain words or images (Void or Copy, etc.) for the motivation of better security and fraud prevention.” *Id.*

The Examiner further states that Yamaguchi is “not explicit and specific [that] the instrument is generated by an issuing financial institution, the funds are certified by the issuing financial institution and the customer holds a deposit account with the issuing financial institution.” *Id.* According to the Examiner, Martin “clearly discloses that a financial entity such as a bank is the generator of the instrument and the bank is grantor of the payment of the face amount to the payee from the payor’s account held at the bank (See Martin abstract, column 3, line 55-column 4, line 2 and column 8, lines 10-19).” *Id.* According to the Examiner, “it would have been obvious to one having ordinary skill in the art at the time the current invention was made to have the financial institution certify the financial instrument created and drawn on an account of an account holder and printed for the motivation of further security of the financial or negotiable instrument and presence of the funds to cover such instrument.” *Id.*

Applicants respectfully submit that, as discussed in Sec. II(A) *supra*, Yamaguchi does not disclose at least the limitation of claims 17 and 28 of transmitting to a customer a composite image comprising a first security image in electronic form added to the electronic form of an instrument that has been requested by the customer for printing by the customer on a medium, wherein the first security image is visible on the instrument printed on the medium. Rather, Yamaguchi discloses making security data from ticket issue request data and user identification data sent from a user via a communications means, making ticket image data from the ticket issue request data and transmitting to the user ticket printing data made by embedding the security data in the ticket image data, where the security data is *invisible* against the ticket image data when the ticket printing data including the ticket image data and the security data is printed on ticket paper by the user. *See* Yamaguchi, [0010], line 44-45; [0012], lines 57-58; [0013], lines 6-7; [0034], lines 7-8; [0050], lines 57-58; [0062], lines 48-49; [0088], lines 31-32; [0091], lines 41-42; [0092], lines 44-45; claims 1, 15, 16; Figs. 5, 22, 23.

Martin similarly does not disclose the limitation of claims 17 and 28 of transmitting to a customer a composite image comprising a first security image in electronic form added to the electronic form of an instrument that has been requested by the customer for printing by the customer on a medium, wherein the first security image is visible on the instrument printed on the medium.

U.S. Patent Appln. Serial No. 09/800,997
Amendment After Final Rejection dated June 13, 2005
August 18, 2005

Applicants respectfully submit that Yamaguchi in combination with Martin does not disclose each and every limitation of claims 17 and 28, and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer. Therefore, Applicants respectfully request that this rejection be withdrawn against claims 17 and 28 for failure to form a *prima facie* case of obviousness.

G. Claim 14.

The Examiner states that Yamaguchi discloses all the limitations of claim 10, and that Chapman "clearly discloses that the . . . instrument can be checks, money orders, stock certificates, passports, other financial instruments, or other documents subject to counterfeiting and forgery (See Chapman abstract, column 1, lines 53-68, and column 4, lines 64-68)." See Final Rejection at ¶ 26. According to the Examiner, "it would have been obvious to one having ordinary skill in the art at the time the current invention was made to include other financial instruments as well as other documents subject to counterfeiting and forgery such as bonds and stock certificates for the motivation of further broadening of the usefulness of the Yamaguchi's invention." *Id.*

As discussed in Sec. II(A), *supra*, Yamaguchi does not disclose at least the limitation of claim 1 of transmitting to a customer a composite image comprising a first security image in electronic form added to the electronic form of an instrument that has been requested by the customer for printing by the customer on a medium, wherein the first security image is visible on the instrument printed on the medium. Rather, Yamaguchi discloses making security data from ticket issue request data and user identification data sent from a user via a communications means, making ticket image data from the ticket issue request data and transmitting to the user ticket printing data made by embedding the security data in the ticket image data, where the security data is *invisible* against the ticket image data when the ticket printing data including the ticket image data and the security data is printed on ticket paper by the user. See Yamaguchi, [0010], line 44-45; [0012], lines 57-58; [0013], lines 6-7; [0034], lines 7-8; [0050], lines 57-58; [0062], lines 48-49; [0088], lines 31-32; [0091], lines 41-42; [0092], lines 44-45; claims 1, 15, 16; Figs. 5, 22, 23.

Chapman discloses a system for verifying the authenticity of a document that bears a number of fields of strings of variable characters such as a check bearing date of issue field, payee field and numeric and alpha amount fields. See Chapman, Abstract; col. 2, lines 54-68..

U.S. Patent Appln. Serial No. 09/800,997
Amendment After Final Rejection dated June 13, 2005
August 18, 2005

The system of Chapman authenticates a document by entry of certain elements written or printed on an instrument into a computer, with the computer generating a code that it compares with a unique code on the instrument. *See* col. 1, lines 53-60. A mismatch between the generated code and the unique code on the instrument indicates fraud. *See* col. 1, lines 60-61. However, Chapman does not disclose at least the limitation of claim 1 of transmitting to a customer a composite image comprising a first security image in electronic form added to the electronic form of an instrument that has been requested by the customer for printing by the customer on a medium, wherein the first security image is visible on the instrument printed on the medium.

Applicants respectfully submit that Yamaguchi in combination with Chapman does not disclose each and every limitation of claim 14 (which depends from claim 1), and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer. Therefore, Applicants respectfully request that this rejection be withdrawn against claim 14 for failure to form a *prima facie* case of obviousness.

H. Claim 70.

Applicants respectfully submit that for at least for the reasons stated in Sec. II(E) *supra* that Yamaguchi in combination with Martin does not disclose each and every limitation of new claim 70, which depends from claim 17, and specifically does not disclose the limitation that the first security image is *visible* on the instrument printed on the medium by the customer. Therefore, Applicants respectfully request that Yamaguchi in view of Martin similarly does not render obvious new claim 70.

U.S. Patent Appln. Serial No. 09/800,997
Amendment after Final Rejection dated June 13, 2005
August 18, 2005

CONCLUSION

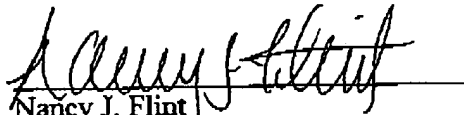
Applicants respectfully request that this Amendment after Final Rejection be entered and all claims 1-28, 66 and 69-72 be allowed. This response has been filed within three (3) months of the mailing date of the Final Rejection and it is believed that no fees are due. If any fees are determined to be due, the Commissioner is hereby authorized to charge or credit that variance to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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